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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/686,608	10/17/2003	Lynn Ann Casey	10761.1477-00	8949
81331	7590	09/16/2011		
Accenture/Finnegan, Henderson, Farabow, Garrett & Dunner, LLP 901 New York Avenue Washington, DC 20001-4413			EXAMINER MCCORMICK, GABRIELLE A	
			ART UNIT 3629	PAPER NUMBER
			NOTIFICATION DATE 09/16/2011	DELIVERY MODE ELECTRONIC

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* LYNN ANN CASEY and MAURINE T. SHIELDS
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11 Appeal 2010-004624
12 Application 10/686,608
13 Technology Center 3600
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17 Before MURRIEL E. CRAWFORD, ANTON W. FETTING, and
18 BIBHU R. MOHANTY, *Administrative Patent Judges*.
19 FETTING, *Administrative Patent Judge*.

20 DECISION ON APPEAL

STATEMENT OF THE CASE¹

Lynn Ann Casey and Maurine T. Shields (Appellants) seek review under 35 U.S.C. § 134 (2002) of a final rejection of claims 13, 20, and 59-75, the only claims pending in the application on appeal. We have jurisdiction over the appeal pursuant to 35 U.S.C. § 6(b) (2002).

The Appellants invented a border management solution (Specification 1:¶ 0002).

An understanding of the invention can be derived from a reading of exemplary claim 13, which is reproduced below [bracketed matter and some paragraphing added].

13. A computer-based system for implementing a border management application architecture comprising:

[1] at least one processor;

[2] at least one computerized database storing border management data; and

[3] at least one computer-readable medium encoding instructions

for implementing a border management application architecture,

wherein said instructions include:

[4] providing a set of core applications

for standard border management functions

in a shared applications architecture,

¹ Our decision will make reference to the Appellants' Appeal Brief ("App. Br.," filed October 21, 2009) and Reply Brief ("Reply Br.," filed January 27, 2010), and the Examiner's Answer ("Ans.," mailed November 27, 2009).

1 wherein the set of core applications includes
2 a process imports application,
3 a process exports application,
4 one or more investigation applications,
5 an entry processing application,
6 an exit processing application, and
7 a form submission and processing
8 application;
9 [5] providing a customer channel interface
10 for interconnecting a set of customer channels
11 that provide individual access points
12 for a plurality of users
13 of the border management application
14 architecture and
15 the set of core applications;
16 [6] providing one or more management access interfaces
17 for interconnecting one or more management
18 access channels
19 with the set of core applications
20 to thereby provide access points and tools
21 for the sharing and access of border
22 management data
23 among the set of core applications; and
24 [7] providing an enforcement database
25 storing case data and individual data;
26 [8] wherein the set of core applications further comprise
27 a set of case management applications,
28 wherein the set of case management applications
29 further comprise
30 a set of intelligence applications

1 used to transform the border management
2 data into intelligence
3 using
4 the shared border management data
5 and
6 the case data and the individual data
7 stored in the enforcement database.

8 The Examiner relies upon the following prior art:

Wong US 6,115,690 Sept. 5, 2000

Bian US 2003/0115133 A1 June 19, 2003

9 Coalition for Secure & Trade-Efficient Borders, Rethinking our Borders:
10 A Plan for Action (Dec. 3, 2001),
11 http://www.canambta.org/Documents/Plan_For_Action.pdf .

12 Guy Gugliotta, *American Responds / Terrorist watch list no match for*
13 *pair / Hijacking suspects eluded all controls*, Houston Chronicle , Sept.
14 24, 2001,
15 [http://proquest.umi.com/pqdweb?did=82197148&sid=2&Fmt=3&client!](http://proquest.umi.com/pqdweb?did=82197148&sid=2&Fmt=3&client!d=19649&RQT=309&VName=PQD&cfc=1.)
16 [d=19649&RQT=309&VName=PQD&cfc=1.\)](http://proquest.umi.com/pqdweb?did=82197148&sid=2&Fmt=3&client!d=19649&RQT=309&VName=PQD&cfc=1.)

17 Claims 59, 64-69, and 71 stand rejected under 35 U.S.C. § 112, first
18 paragraph, as lacking a supporting written description within the original
19 disclosure.²

20 Claims 13, 20, 60-62, 70, and 72-74 stand rejected under 35 U.S.C. §
21 103(a) as unpatentable over Wong and Coalition.

² The Examiner also included claims 13, 20, 60-63, 70, and 72-75 in this rejection at Final Rejection 2. The rejection as to these claims was withdrawn at Answer 2.

1 Claims 59, 64-67, and 71 stand rejected under 35 U.S.C. § 103(a) as
2 unpatentable over Wong, Coalition, and Bian.

3 Claims 68 and 69 stand rejected under 35 U.S.C. § 103(a) as
4 unpatentable over Wong, Coalition, Bian, and Gugliotta.

5 ISSUES

6 The issue of written description turns on whether the Appellants
7 described sufficient species to show they were in possession of the genus.

8 The issue of obviousness turns on whether the modules recited in the
9 claims are to be given patentable weight.

10 FACTS PERTINENT TO THE ISSUES

11 The following enumerated Findings of Fact (FF) are believed to be
12 supported by a preponderance of the evidence.

13 *Facts Related to the Prior Art*

14 *Wong*

15 01. Wong is directed to business to business web commerce. Wong
16 1:11-12.

17 *Coalition*

18 02. Coalition is directed to an integrated plan for border
19 management. Coalition 1:First ¶.

20 *Bian*

21 03. Bian is directed to a way to ascertain business risk. Bian ¶
22 0001.

ANALYSIS

Claims 59, 64-69, and 71 rejected under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure.

We are unpersuaded by the Appellants' arguments that the original disclosure provides adequate support for the generic tools recited in the claims. For example, claim 59 recites an information synthesis application and a risk scoring and analytics application that applies neural networks, decision tree analysis, data recognition techniques, and rules-based algorithms to synthesize information, identify patterns, analyze historical information, and develop risk scores. The Appellants have not disclosed any specific implementations of these tools and techniques.

Although many original claims will satisfy the written description requirement, certain claims may not. For example, a generic claim may define the boundaries of a vast genus of chemical compounds, and yet the question may still remain whether the specification, including original claim language, demonstrates that the applicant has invented species sufficient to support a claim to a genus. The problem is especially acute with genus claims that use functional language to define the boundaries of a claimed genus. In such a case, the functional claim may simply claim a desired result, and may do so without describing species that achieve that result. But the specification must demonstrate that the applicant has made a generic invention that achieves the claimed result and do so by showing that the applicant has invented species sufficient to support a claim to the functionally-defined genus.

Ariad Pharms., Inc. v. Eli Lilly & Co., 598 F.3d 1336, 1349 (Fed. Cir. 2010). The Appellants describe language in the Specification at Appeal Brief 28-30 that either echoes the claim language or describes activities in which such tools and techniques might occur, but none that describe actual

1 species that would show possession of the genus of the tools and techniques
2 recited.

3 We are unpersuaded by the Appellants' arguments regarding claims 65-
4 69 because these claims include the limitations from their parent claim 64.

5 *Claims 13, 20, 60-62, 70, and 72-74 rejected under 35 U.S.C. § 103(a) as*
6 *unpatentable over Wong and Coalition.*

7 *Claims 59, 64-67, and 71 rejected under 35 U.S.C. § 103(a) as unpatentable*
8 *over Wong, Coalition, and Bian.*

9 *Claims 68 and 69 rejected under 35 U.S.C. § 103(a) as unpatentable over*
10 *Wong, Coalition, Bian, and Gugliotta.*

11 We are persuaded by the Appellants' arguments that the art fails to
12 describe the structure as claimed.

13 As the Appellants contend, the Examiner simply asserted , erroneously,
14 that the names of the databases and applications and the descriptive nature of
15 the data are non-functional.

16 The names of the databases, core applications and data identify
17 their functionality. By identifying the names of core
18 applications, it is thus known what functions are to be
19 performed by the core applications. For example, the core
20 applications are identified as including "case management
21 applications 320 [including] intelligence applications 3210,
22 such as information synthesis 3212, and risk scoring and
23 analytics 3214." Specification pg. 18, para. 60, lines 4-11. It
24 will be apparent from the name of a risk scoring and analytics
25 application that the software is configured to perform a risk
26 scoring and analytics function. Similarly, by identifying the
27 types of data and databases, it is thus known what functions the
28 data and databases are to perform in the recited border
29 management application architecture.

Appeal Br. 35-36. The independent claims recite computer implemented structures that perform specific functions pertinent to border management. The Examiner found that the art's structure describing a financial data product that analyzed risk using a neural net met those limitations. We fail to see how a business risk system describes a border management system with the functions recited in the claims. We find it was improper for the Examiner to give no patentable weight to the recited functions since the functions narrowed the structure of the system.

CONCLUSIONS OF LAW

The rejection of claims 59, 64-69, and 71 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is proper.

The rejection of claims 13, 20, 60-62, 70, and 72-74 under 35 U.S.C. § 103(a) as unpatentable over Wong and Coalition is improper.

The rejection of claims 59, 64-67, and 71 under 35 U.S.C. § 103(a) as unpatentable over Wong, Coalition, and Bian is improper.

The rejection of claims 68 and 69 under 35 U.S.C. § 103(a) as unpatentable over Wong, Coalition, Bian, and Gugliotta is improper.

DECISION

To summarize, our decision is as follows.

- The rejection of claims 59, 64-69, and 71 under 35 U.S.C. § 112, first paragraph, as lacking a supporting written description within the original disclosure is sustained.

- 1 • The rejection of claims 13, 20, 60-62, 70, and 72-74 under 35 U.S.C.
2 § 103(a) as unpatentable over Wong and Coalition is not sustained.
- 3 • The rejection of claims 59, 64-67, and 71 under 35 U.S.C. § 103(a) as
4 unpatentable over Wong, Coalition, and Bian is not sustained.
- 5 • The rejection of claims 68 and 69 under 35 U.S.C. § 103(a) as
6 unpatentable over Wong, Coalition, Bian, and Gugliotta is not
7 sustained.

8 No time period for taking any subsequent action in connection with this
9 appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R.
10 § 1.136(a)(1)(iv) (2007).

AFFIRMED-IN-PART